REMARKS

The non-final Office Action dated October 25, 2010 has been received and reviewed. Claims 10-11, 15, 17-18, 20, 22, 24-28, and 30-37 are pending in the subject application. All claims stand rejected. Each of claims 10, 27, 28, and 36 has been amended herein. Care has been exercised to introduce no new matter. Applicants respectfully request reconsideration of the present application in view of the above amendments and the following remarks.

Rejections based on 35 U.S.C. § 112

Claims 22, 24, 27, 28 and 31 have been rejected under 35 U.S.C. § 112, first paragraph, as ostensibly failing to comply with the written description requirement. In particular, the Office contends that Applicants' specification at ¶ [59] does not disclose a second pointer that points between additional context information and content as claimed. Applicants respectfully traverse said rejection for the following reasons.

Paragraph [59] and the associated Fig. 9 describe just one content box and just one context box for simplicity of discussion. Paragraphs [79]-[80] describe, "the system obtains a *text pointer* from the element or starts at a default location in the text and *starts working its way through the text* … For example, the text could be navigated through at a *character-by-character level or at a word-by-word level* … The system may navigate through the text and, *for each character or word in the text, determines the bounding box for the character or word.* Next in step 1405, the system compares this bounding box with the region that defines the selection. If the character or word is determined to lie entirely within the region, the system then looks up the word or character corresponding to the bounding box and includes this character or word with the *harvested context* in step 1406 … *The system then repeats the process with the next character*

or word in the text." Applicants' specification clearly provides for more than one content identification and more than one context identification. It would also stand to reason that a method or system for identifying information would provide for identifying more than one instance of information. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, first paragraph, rejection of claims 22, 24, 27, 28 and 31.

Claim 36 has been rejected under 35 U.S.C. § 112, second paragraph, as the recitation of "any subsequent sets of textual characters reside outside the path drawn by the user" is ostensibly unclear. The Office further maintained that any textual characters not in the selected region when the region is selected are inherently outside the path drawn. Applicants respectfully traverse said rejection for the following reasons.

Claim 36 was previously objected to for the same reason (*see 6/24/10 OA*, p.3). Textual characters that are *subsequently* drawn (*i.e.*, drawn *after* the path has been drawn) could be *either inside or outside* the drawn path. As an example for illustrative purposes only, if a 3" x 3" square (9 square inches) is drawn in the middle of a 6" x 6" screen (36 square inches), then any *subsequently drawn* characters would have a 75% probability of being drawn outside the square and a 25% probability of being drawn inside the square. Therefore, Applicants maintain that said recited feature is not unclear and would not inherently lead to the assumption made by the Office.

Rejections based on 35 U.S.C. § 103

A)   Applicable Authority

Title 35 U.S.C. § 103(a) declares, a patent shall not issue when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

ordinary skill in the art to which said subject matter pertains." The Supreme Court in *Graham v. John Deere* counseled that an obviousness determination is made by identifying: the scope and content of the prior art; the level of ordinary skill in the prior art; the differences between the claimed invention and prior art references; and secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). To support a finding of obviousness, the initial burden is on the Office to apply the framework outlined in *Graham* and to provide some reason, or suggestions or motivations found either in the prior art references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the prior art reference or to combine prior art reference teachings to produce the claimed invention. See *Application of Bergel*, 292 F.2d 955, 956-957 (CCPA 1961).

      B)   Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), WO 2001/42980 (hereinafter "Woolf"), and U.S. Publication No. 2003/0182630 (hereinafter "Saund")

      Claims 10, 20-22, 30, 36 and 37 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, and further in view of Woolf and Saund. As a *prima facie* case of obviousness cannot be established based upon the asserted references, Applicants respectfully traverse said rejection for the following reasons.

      Independent claim 10 has been amended to recite, in part, "wherein certain context information is prevented from associating with the one or more graphical elements based upon digital rights management preventive measures." The prior art of record, either alone or in any combination, does not describe or suggest all cited features of amended independent claim 10, thereby placing amended independent claim 10 as well as dependent claims 20, 22, 30, and 36-37 in allowable condition. Claim 21 was previously canceled, thereby rendering its rejection

moot. Therefore, Applicants respectfully request withdrawal of said rejection and allowance of claims 10, 20-22, 30, 36 and 37.

        C)   <u>Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), WO 2001/42980 (hereinafter "Woolf"), U.S. Publication No. 2003/0182630 (hereinafter "Saund"), and U.S. Pat. No. 6,334,157 (hereinafter "Oppermann")</u>

        Claims 11, 25 and 26 have eben rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, Woolf and Saund, and further in view of Oppermann. As a *prima facie* case of obviousness cannot be established based upon the asserted references, Applicants respectfully traverse said rejection for the following reasons.

        Claims 11, 25, and 26 depend from amended independent claim 10, which was previously shown to be allowable over the prior art of Denoue, Dawe, Woolf and Saund. Oppermann does not compensate for the deficiencies of Denoue, Dawe, Woolf and Saund in describing or suggesting all cited features of amended independent claim 10. Therefore, dependent claims 11, 25, and 26 are also allowable over the prior art of record at least for the same reasons, and Applicants respectfully request withdrawal of said rejection and allowance of claims 11, 25, and 26.

        D)   <u>Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), WO 2001/42980 (hereinafter "Woolf"), U.S. Publication No. 2003/0182630 (hereinafter "Saund"), and U.S. Pub. No. 2004/0135815 (hereinafter "Browne")</u>

        Claims 15, 18, 32 and 33 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, Woolf, and Saund, and further in view of Browne.

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As a *prima facie* case of obviousness cannot be established based upon the asserted references, Applicants respectfully traverse said rejection for the following reasons.

Claims 15, 18, 32 and 33 depend from amended independent claim 10, which was previously shown to be allowable over the prior art of Denoue, Dawe, Woolf and Saund. Browne does not compensate for the deficiencies of Denoue, Dawe, Woolf and Saund in describing or suggesting all cited features of amended independent claim 10. Therefore, dependent claims 15, 18, 32 and 33 are also allowable over the prior art of record at least for the same reasons, and Applicants respectfully request withdrawal of said rejection and allowance of claims 15, 18, 32 and 33.

E)   Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), WO 2001/42980 (hereinafter "Woolf"), U.S. Publication No. 2003/0182630 (hereinafter "Saund"), and U.S. Pub. No. 2004/0201633 (hereinafter "Barsness")

Claim 22 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue, in view of Dawe, Woolf, and Saund, and further in view of Barsness. As a *prima facie* case of obviousness cannot be established based upon the asserted references, Applicants respectfully traverse said rejection for the following reasons.

Claim 22 depends from amended independent claim 10, which was previously shown to be allowable over the prior art of Denoue, Dawe, Woolf and Saund. Barsness does not compensate for the deficiencies of Denoue, Dawe, Woolf and Saund in describing or suggesting all cited features of amended independent claim 10. Therefore, dependent claim 22 is also allowable over the prior art of record at least for the same reasons, and Applicants respectfully request withdrawal of said rejection and allowance of claim 22.

F)   Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), WO 2001/42980 (hereinafter "Woolf"), U.S. Publication No. 2003/0182630 (hereinafter "Saund"), and U.S. Pub. No. 2002/0076109 (hereinafter "Hertzfeld")

Claims 32 and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, Woolf, and Saund, and further in view of Hertzfeld. As a *prima facie* case of obviousness cannot be established based upon the asserted references, Applicants respectfully traverse said rejection for the following reasons.

Claims 32 and 35 depend from amended independent claim 10, which was previously shown to be allowable over the prior art of Denoue, Dawe, Woolf and Saund. Hertzfeld does not compensate for the deficiencies of Denoue, Dawe, Woolf and Saund in describing or suggesting all cited features of amended independent claim 10. Therefore, dependent claims 32 and 35 are also allowable over the prior art of record at least for the same reasons, and Applicants respectfully request withdrawal of said rejection and allowance of claims 32 and 35.

G)   Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), WO 2001/42980 (hereinafter "Woolf"), U.S. Publication No. 2003/0182630 (hereinafter "Saund"), and U.S. Pub. No. 2006/0100849 (hereinafter "Chan")

Claim 34 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, Woolf and Saund, and further in view of Chan. As a *prima facie* case of obviousness cannot be established based upon the asserted references, Applicants respectfully traverse said rejection for the following reasons.

Claim 34 depends from amended independent claim 10, which was previously shown to be allowable over the prior art of Denoue, Dawe, Woolf and Saund. Chan does not compensate for the deficiencies of Denoue, Dawe, Woolf and Saund in describing or suggesting all cited features of amended independent claim 10. Therefore, dependent claim 34 is also allowable over the prior art of record at least for the same reasons, and Applicants respectfully request withdrawal of said rejection and allowance of claim 34.

H)   Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), WO 2001/42980 (hereinafter "Woolf"), U.S. Publication No. 2003/0182630 (hereinafter "Saund"), U.S. Pub. No. 2004/0135815 (hereinafter "Browne"), and U.S. Pub. No. 2003/0101156 (hereinafter "Newman")

Claim 17 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, Woolf, Saund, and Browne, and further in view of Newman. As a *prima facie* case of obviousness cannot be established based upon the asserted references, Applicants respectfully traverse said rejection for the following reasons.

Claim 17 depends from amended independent claim 10, which was previously shown to be allowable over the prior art of Denoue, Dawe, Woolf and Saund. Neither Browne nor Newman compensate for the deficiencies of Denoue, Dawe, Woolf and Saund in describing or suggesting all cited features of amended independent claim 10. Therefore, dependent claim 17 is also allowable over the prior art of record at least for the same reasons, and Applicants respectfully request withdrawal of said rejection and allowance of claim 17.

I)   Obviousness Rejection Based on U.S. Pub. No. 2004/0119762 (hereinafter "Denoue"), U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), U.S. Pub. No. 2002/0076109 (hereinafter "Hertzfeld"), U.S. Pub. No. 2006/0100849 (hereinafter "Chan"), and U.S. Pub. No. 2004/0135815 (hereinafter "Browne")

Claims 24 and 27 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Denoue in view of Dawe, Hertzfeld, Chan, and Browne. As a *prima facie* case of obviousness cannot be established based upon the asserted references, Applicants respectfully traverse said rejection for the following reasons.

Independent claim 27 has been amended to recite, in part, "capturing the plurality of pixels and associated underlying text and associated links to embedded information of the on-screen region by capturing only complete characters or words." The prior art of record, either alone or in any combination, does not describe or suggest all cited features of amended independent claim 27, thereby placing amended independent claim 27 as well as dependent claim 24 in allowable condition. Therefore, Applicants respectfully request withdrawal of said rejection and allowance of claims 24 and 27.

J)   Obviousness Rejection Based on U.S. Pat. No. 7,042,594 (hereinafter "Dawe"), WO 2001/42980 (hereinafter "Woolf"), U.S. Pub. No. 2002/0076109 (hereinafter "Hertzfeld"), and U.S. Pub. No. 2004/0201633 (hereinafter "Barsness")

Claims 28 and 31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Dawe, in view of Woolf, Hertzfeld, and Barsness. As a *prima facie* case of obviousness cannot be established based upon the asserted references, Applicants respectfully traverse said rejection for the following reasons.

Independent claim 28 has been amended to recite, in part, "automatically extracting as additional context information … a separate linking structure comprising identifying information which relates the selected content to the context information." The prior art of record, either alone or in any combination does not describe or suggest all cited features of amended independent claim 28, thereby placing amended independent claim 28 as well as dependent claim 31 in allowable condition. Therefore, Applicants respectfully request withdrawal of said rejection and allowance of claims 28 and 31.

CONCLUSION

For at least the reasons stated above, claims 10-11, 15, 17-18, 20, 22, 24-28, and 30-37 are believed to be in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of the claims. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned – 202-783-8400 or nberezny@shb.com (such communication via email is herein expressly granted) – to resolve the same.

It is believed that no fee is due. However, if that belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112 with reference to Attorney Docket Number 306171.01/MFCP.153380.

Respectfully submitted,

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